

### **REMARKS/ARGUMENTS**

Claims 1-5, 7-9, 11-13, 15-22 and 25-30 are pending. Claims 10 and 14 have been cancelled. New Claims 25-30 have been added to further define Applicant's invention. Support for Claims 25-30 is found on page 10, lines 12-32 and page 11, lines 1-16 and page 7, lines 4-8 of Applicant's specification. No new matter has been added.

#### **Claim Rejections – 35 USC §§ 102, 103**

Claims 1-5, 7-9, 11-15, 17-18, 20-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshikazu Nishimura et al. ("Yoshikazu", EP publication No. 0 516 378 A1). Claims 10 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshikazu. Applicant respectfully traverses. However Claims 10 and 14 have been cancelled.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984)) (emphasis added).

Applicant respectfully submits that amended independent Claims 1, 11, 15, and 20 include elements that have not been disclosed, taught or suggested by Yoshikazu. For example, Yoshikazu fails to teach, disclose or suggest the element of "an information storage media player" which is capable of encoding data onto a vertical blanking interval of a video signal. Instead, Yoshikazu merely teaches a camera controlling system comprising a video camera for generating a video signal and a camera control unit for

generating a control signal for the video camera. The camera controlling system is designed for use by broadcasting stations. The system provides a bidirectional communication between the camera control unit and the video camera via a very high frequency (VHF) transmitter. The video camera for generating a video signal in Yoshikazu is not equivalent to "an information storage media player" as recited in amended independent Claims 1, 11, 15, and 20. Therefore, under *Lindemann*, a *prima facie* case of anticipation has not been established. Removal of the pending rejection to Claims 1, 11, 15, and 20 under 35 U.S.C. §102 is respectfully requested. Claims 2-5 and 7-9 depend on Claim 1, Claims 12-13 depend on Claim 11, Claims 17-18 depend on Claim 15, Claims 21-22 and 24 depend on 20. Claims 2-5, 7-9, 12-13, 17-18, 21-22 and 24 are therefore believed to be allowable due to their dependency on allowable base claims.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Further, when applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 10 stands rejected under 35 U.S.C. §103(a). However, Claim 10 has been cancelled and the feature of Claim 10 has been incorporated into Claim 1. In rejecting Claim 10, the Examiner asserts and gives Official Notice that "it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the old and well

known signal processor being an information storage media into Yoshikazu Nishimura et al's system in order to increase flexibility of the system by adding different video sources." As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. § 2144.03. Thus, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting this statement. If the Examiner is unable to provide such a reference, and is relying on facts within his own personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. § 104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Claim 19 stands rejected under 35 U.S.C. §103(a). Applicant respectfully traverses. As indicated in the forgoing arguments, Yoshikazu fails to disclose, teach or suggest all the elements recited in amended independent Claim 15. Therefore, Claim 15 is nonobvious under 35 U.S.C. 103. Claim 19 is believed to be allowable due to its dependency on Claim 15.

#### New Claims

New claims 27-30 are directed to a convergence system capable of communicating state information using a vertical blanking interval of a video signal, comprising: a computer system for controlling the convergence system; a television monitor coupled to the computer system for displaying video images; an information storage media player coupled to at least one of the computer system and the television monitor for receiving a storage medium containing video information stored thereon and providing an output video signal having a vertical blanking interval to at least one of the computer system and the television monitor; wherein the information storage media player receives and decodes a control signal from the computer system and in response thereto encodes status data within the vertical blanking interval of the output video signal, the encoded status data being decodable by the computer system for acquiring the status of the information storage

media player. Applicant submits that the cited references and the prior art in general fail to disclose, teach or suggest the convergence system recited in claims 27-30. Accordingly, it is believed that claims 27-30 are patentable, and allowance of these claims is requested.

**CONCLUSION**

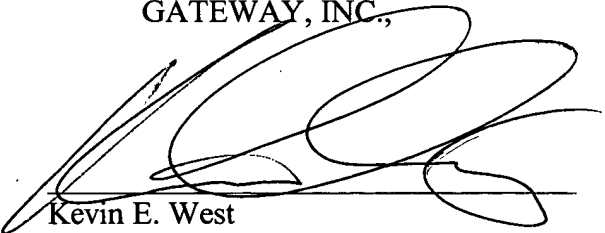
In light of the foregoing arguments, reconsideration of all pending claims is requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

GATEWAY, INC.,

Date: May 14, 2004

By:

  
Kevin E. West  
Reg. No. 43,983

SUITER · WEST PC LLO  
14301 FNB Parkway, Suite 220  
Omaha, Nebraska 68154  
Telephone 402.496.0300  
Facsimile 402.496.0333